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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,680	09/28/2001	James R. Hornsby	6881.03	5486
42173	7590	10/19/2005		
LAW OFFICE OF RICHARD B. KLAR 28 East Old Country Road Hicksville, NY 11801			EXAMINER SUHOL, DMITRY	
			ART UNIT 3725	PAPER NUMBER

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/966,680	Applicant(s) HORNSBY ET AL.	
	Examiner Dmitry Suhol	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 and 32-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 and 32-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 27 and 36, the features/relationship between the motor utilized in the launching of an element and the association of a swipe card therewith was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be any relationship disclosed in the original disclosure of a swipe card functioning to activate a motor which in turn launches an element.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 41, the claim dependency could not be established since the claim is dependent from canceled claim 1. Additionally, the phrase "and/or" renders the claim indefinite since the metes and bound of the claim can not be established.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-23 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al '223 in view of Wooley et al '791. Li discloses an amusement device containing all of the elements of the claims including a body (fig. 20, element A) as required by claims 22 and 37, features carried by a body at least some of the features comprising at least one transport element moveably connected to the body or at least two arms moveably connected to the body (movable elements coupled to a motor described in col. 7, lines 50-64) (fig. 20, elements B) as required by claim 22, a means for powering a device and some features carried by the body (col. 4, lines 22-26) as required by claim 22, a card reader carried by the body (data card reader and col. 7, lines 59-64 and fig. 20, element 210) as required by claim 22 and 37, a microprocessor

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operably coupled to a means for powering, a card reader and motor (fig. 17, element 25 and col. 5, lines 21-23) as required by claims 22 and 37. The card reader adapted to receive information from the card and transmit the information to the microprocessor, where the information activates one or more functions of movement and defense, as required by claims 22 and 37, is described in col. 7, lines 59-64. An information card, as required by claim 23, is shown in figure 1 as element 10 and described in col. 7, lines 59-64 with the card game information shown in figure 1 as picture information and data information 12. A motor associated with the body, as required by claim 37, is shown as element 62 in figure 20. At least two movable elements, as required by claim 37, are shown as elements (B) where it is considered that the arms or legs of the device are reconfigurable to a different position in which case the device is transformed. At least two couplings, as required by claim 38, are inherent in the device since without the coupling the movable elements would not be retained on the body nor would they be movable as intended (col. 7, lines 50-56).

Li lacks a teaching of a card reader being of a swipe card type. However, Wooley discloses a swipe card reader used to synthesize commands for generating speech or sound in a variety of devices including games (col. 1, lines 25-31 and col. 2, lines 3-7). Therefore it would have been obvious to incorporate a swipe card reader for the card reader of Li for the purpose of providing an improved data storage and retrieval system which controls voice or sound synthesizer, especially since one of the uses of the cards of Li is for the generation of sound.

Claims 22-23, 25-26, 32-35, 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld '166 in view of Mathieu et al '486 and Hara '368.

Lebensfeld discloses an interactive amusement device capable of a variety of scenarios and using a multiple of different accessories (col. 4, lines 56-62), containing most of the elements of the claims including with reference to claims 22, 25, 32 and 37, a body (fig. 4, element 10), at least two transport elements (features carried by the body) movably connected to a body (fig. 1, legs), at least two arms movably connected to a body (fig. 1, elements 47 and col. 7, lines 31-36), a microprocessor (figure 6, element 60). Data providing changes for at least two functions, as required by claim 32, is taught in col. 9, lines 35-43 with changes being speed of functions is described in col. 6, lines 26-28 where single shot, semi-automatic shooting and automatic shooting is clearly a speed of a shot function. Movement of the device as required by claim 37 is described in col. 9, lines 49-54. Control switches, as required by claim 34, are described in col. 5, lines 52-56. At least two couplings, as required by claim 38, are described in col. 7, lines 30-39. Defense capabilities, as required by claims 39 and 40, are described in col. 6, lines 31-34 (i.e. different hit values). Regarding sound, as required by claim 41, such limitations are described in col. 9, lines 55+.

Although Lebensfeld et al discloses most of the elements of the claims the reference fails to teach a motor associated with a body and coupled to two transport elements as required by claims 25, 32 and 37, a wireless receiver associated with a body as required by claims 25 and 32, a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 25 and 32, a remote wireless

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transmitter operably coupled with a wireless receiver as required by claims 25 and 32, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 25 and 32. However, Mathieu discloses an interactive amusement device like that of Lebensfeld, which teaches a motor associated with a body and coupled to two transport elements (fig. 6, elements 42), a wireless receiver associated with a body (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor (figure 1, element 20), a remote wireless transmitter operably coupled with a wireless receiver (figure 1, element 46). Therefore it would have been obvious in view of Mathieu, to manufacture the device of Lebensfeld with the above mentioned features for the purpose of providing a remote controlled device that can simulate a "battle" scenario.

Regarding a swipe card reader and associated swipe card and card game information displayed on the face of the swipe information card, as well as, device actuation information, Hara discloses a toy apparatus which teaches that it is known to provide toys with a card reader (3) and associated swipe card (1) to modify/enhance character functions, where the swipe cards contain both card game information and device actuation information (cols. 2-3, lines 58+ and 1-16, respectively). Therefore it would have been obvious to utilize swipe cards and associated card reader in the device of Lebensfeld to modify character parameters in the backpack, especially since Lebensfeld clearly intends for his toys to have characteristics which may be modified (col. 9, lines 35-42).

Regarding an on/off switch as required by claim 35, it would have been obvious to include such a switch since Lebensfeld clearly encompasses the use of a variety of switches in col. 5, lines 54-56 and since the examiner takes official notice that the use of on/off switches is conventional in the art in order to save power and durability of the toy.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al '223 and Wooley et al '791, as stated above, and further in view of Mowrer et al '716. Li, as modified by Wooley, fails to explicitly teach armor configured to be attachable to a body, as required by claim 24. However, Mowrer discloses a sound producing amusement device which can be embodied as any type of figure which teaches that it is known to provide armor which is attachable to the body of the device (col. 2, lines 61-63). Therefore it would have been obvious to incorporate armor attachable to a body portion with the device of Li, as modified by Wooley, for the purpose of adding a variety of ornamental surface details and interest to the user.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld '166, Mathieu et al '486 and Hara '368, as stated above, and further in view of Mowrer et al '716. Lebensfeld, as modified by Mathieu and Hara, fails to explicitly teach armor configured to be attachable to a body, as required by claim 24. However, Mowrer discloses a sound producing amusement device which can be embodied as any type of figure which teaches that it is known to provide armor which is attachable to the body of the device (col. 2, lines 61-63). Therefore it would have been obvious to

incorporate armor attachable to a body portion with the device of Lebensfeld, as modified by Mathieu and Hara, for the purpose of adding a variety of ornamental surface details and interest to the user.

Claims 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al '906 in view of Broadfield (WO 95/30973). Heller discloses most of the claimed elements including a body (10), a launchable element associated with the body (balls 11), a launch mechanism associated with the body (29) and a motor (23).

Heller fails to teach a swipe card reader as required by claims 27 and 36. However, Broadfield discloses an amusement device which teaches that it is known to employ a card swipe reader to facilitate a financial transaction through a credit card (see abstract 1st paragraph at page 2). Therefore since Heller discloses a motor which is actuated upon deposit of money (26) it would have been obvious to employ a card swipe reader in the device of Heller for the purpose of allowing a quick and easy financial transaction.

Response to Arguments

Applicant's arguments filed August 4th, 2005 have been fully considered but they are not persuasive. Applicants argue that the combination of Li and Wooley references fails to teach all of the claimed elements. Specifically, applicants argue that since the data swipe card teachings of Wooley are limited to controlling sound then the combination of the references does not meet the limitations of activating at least one

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function of movement or defense. In response, the examiner points out that Li teaches a card reader responsive to card information which activates sound and movement functions. Wooley is merely relied upon to teach that information carried on a card (as well as the card reader) can be in swipe format. Therefore, since Li already teaches movement of his device in response to the information carried by his card all the combination of Li and Wooley clearly meet the claimed limitations.

Applicants further argue that the motivation to combine the Li and Wooley references is based upon hindsight reconstruction. In response, the examiner points out that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case both Li and Wooley are directed to a device which produces sound in response to information carried on cards. Wooley improves on the data storage capability of the cards by providing for a multidimensional bar code matrix which is capable of storage of a large amount of information and has a variety of uses including game devices. Therefore one having ordinary skill in the art would have certainly looked to the teachings of both Li and Wooley at the time of the applicants invention.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
Art Unit 3725

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